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Response Under 37 C.F.R. § 1.116  
Expedited Procedure  
Examiner Group 2615

PATENT  
ATTORNEY DOCKET NO. 041465-5065

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Takao SAWABE et al. )  
)  
Application No.: 09/288,643 )  
)  
Filed: April 9, 1999 )  
)  
For: INFORMATION RECORD MEDIUM )  
AND APPARATUS FOR REPRODUCING )  
THE SAME )

Group Art Unit: 2615  
Examiner: J. Fletcher

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Commissioner for Patents  
U.S. Patent and Trademark Office  
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Arlington, VA 22202

Sir:

**RESPONSE AND REQUEST FOR RECONSIDERATION**

In response to the Final Office Action dated February 7, 2003 (Paper No. 5), the period of response to which extends through June 7, 2003 by the concurrently filed petition for a one-month extension of time and corresponding fee payment, reconsideration and withdrawal of the rejections set forth in the outstanding Final Office Action are respectfully requested.

**All Claims Define Allowable Subject Matter**

In the Final Office Action, claims 1-14 and 16-30 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Fuchigami et al. (U.S. Patent No. 6,160,953) (hereinafter "Fuchigami"). Claims 32-38 stand rejected under 35 U.S.C. § 102(b) as allegedly

being anticipated by Kojima (U.S. Patent No. 5,991,496) (hereinafter "Kojima"). Claims 15 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuchigami in view of Mizoguchi et al. (U.S. Patent No. 6,169,847) (hereinafter "Mizoguchi"). These rejections are respectfully traversed for at least the following reasons. ✓

In the Amendment filed on November 21, 2002, Applicants explained that Fuchigami fails to teach or suggest control information including at least "a plurality of first division information for identifying first division units respectively so as to divide each of the plurality of audio information recorded on the audio information recording area by the first division units respectively," as recited by each of independent claims 1, 8 and 16.

At page 3 of the Final Office Action, the Examiner disagrees with this argument by alleging that Fuchigami "broadly discloses the use of an audio frame information subpacket to identify the type of audio recording in the packet."

Applicants respectfully submit that the claimed invention goes on to define the first division information further as indicating "that the audio information divided by the first division units belong to a same first division unit, being provided for each of the plurality of audio information same in content and different in recording method, the plurality of audio information same in content and different in recording method... being recorded on recording positions different from each other in the audio information recording area."

As described throughout the specification, for example at page 7, lines 17-23, an important concept of the instant invention is to allow a plurality of audio information recordings (such as songs, for example), of which two or more are the same in audio content, but different in recording method (same song, but recorded more than once using respectively different

recording formats, for example), to be recorded on one record medium (optical disk, for example) and recorded at different areas of the record medium.

Applicants respectfully submit that the instant invention minimizes user confusion by providing control information (ATSI, for example) that includes a plurality of first division information that identifies first division units (titles, for example). When the user makes a selection (a track or song to listen to, for example), the first division information is used to identify that the two or more songs, which are the same in content but different in recording method, belong to the same title. Even though different versions of the selection may exist in multiple respective recording formats on the medium, as discussed above, the format compatible with the user's reproduction apparatus will be chosen. As discussed throughout the specification, this minimizes user confusion when utilizing a high density disc including selections recorded in multiple recording formats..

In the Final Office Action, the Examiner interprets "the use of an audio frame information subpacket to identify the type of audio recording in the packet" as meeting the first division information for identifying first division units. However, Applicants respectfully traverse this interpretation because the use of an information subpacket to identify the type of audio recording in the packet does not meet the "first division information" and the "first division units" recitations of the claims for at least the following reasons.

Applicants respectfully submit that the audio frame information subpacket disclosed in Fuchigami does not serve as a division unit for dividing of a plurality of audio information (songs, for example) which are the same in content and different in recording method (the same songs, but recorded in different formats, for example). Fuchigami may disclose recording a plurality of audio signals having different recording formats, and designating the recording

format of a particular audio recording with an audio frame information subpacket, as pointed out by the Final Office Action. However, Fuchigami does not teach or suggest recording the same information multiple times with respectively different formats. Even more importantly, Fuchigami does not teach or suggest providing “first division units” for designating a group of audio information having different recording formats, but which are the same in audio content, as recited in each of independent claims 1, 7, 8, 16, 18 and 24.

Moreover, independent claims 16, 18 and 24 go on to recite “second division information for identifying second division units respectively so as to divide each of the plurality of audio information recorded on the recording positions different from each other in the audio information recording area by the second division units” The second division units are recited as dividing the plurality of audio information which are same in content and different in recording method. Thus, they assist in locating the specific selection within a track, for example, that is recorded in a format that is compatible with the user’s reproduction device.

Therefore, Applicants respectfully submit that independent claims 1, 7, 8, 16, 18 and 24 clearly distinguish from Fuchigami for at least the reasons set forth above. Also, Applicants respectfully traverse the rejections of claims 2-6, 9-14, 17, 19-23 and 25-30 at least because of their respective dependence upon independent claims 1, 8, 16, 18 and 24 and for the reasons set forth above.

Claims 32-38 stand rejected under 35 U.S.C. §102(b) as being anticipated by Kojima. Applicants respectfully submit that Kojima discloses a hard disk medium used within a hard disk drive arrangement. Kojima does not teach or suggest at least “a video zone ... comprising a plurality of audio streams is recorded and a reproduction control information recording area is formed,” as recited in independent claims 32 and 38.

Therefore, Applicants respectfully submit that independent claims 32 and 38 clearly distinguish from Kojima for at least the reasons set forth above. Also, Applicants respectfully traverse the rejections of claims 33-37 at least because of their respective dependence upon independent claim 32, and for the reasons set forth above.

Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) should be withdrawn because Fuchigami does not teach or suggest each feature of independent claims 1, 7, 8, 16, 18 and 24. Moreover, Kojima does not teach or suggest each feature of independent claims 32 and 38. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that dependent claims 2-6, 9-14, 17, 19-23, 25-30 and 33-37 are allowable at least because of the dependence from their respective independent claims, and the reasons set forth above.

With regard to the rejection of dependent claims 15 and 31 under 35 U.S.C. §103(a) as being unpatentable over Fuchigami in view of Mizoguchi, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as independent claims 8 and 24 on which they depend and that Mizoguchi fails to cure the deficiencies set forth above with regard to Fuchigami.

**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims 1-38.


Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: June 5, 2003

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